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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKA GRUNDSTROM

Appeal 2008-002152
Application 09/990,039
Technology Center 2400

Decided:¹ June 4, 2009

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-112. We have jurisdiction under 35 U.S.C. § 6(b). We affirm in part.

The Invention

The disclosed invention relates generally to using address information in a data packet header as a selection criteria to select a packet from a plurality of packets (Spec. 2).

Independent claim 1 is illustrative:

1. A method for constructing a data packet having both a payload segment that carries data associated with a link layer (MAC) or network layer (IP) address and a header segment that has one or more fields, the method comprising:

generating an address value based on the IP or MAC address;

formatting the address value; and

populating the formatted address value into a field of the header that will be used as a selection criteria by a receiving terminal.

The References

The Examiner relies upon the following references as evidence in support of the rejections:

| | | |
|---------|-----------------|---------------|
| Bigham | US 5,544,161 | Aug. 06, 1996 |
| Momirov | US 6,216,167 B1 | Apr. 10, 2001 |
| Chauvel | US 6,226,291 B1 | May 01, 2001 |

The Rejections

1. The Examiner rejects claims 1-3, 5, 7-13, 15, 17-23, 25, 27-30, 32-40, 42-50, 52-60, 63, 64, 66, 68-72, 74, 76-80, 82, 84-86, 88-93, 95-100, 102-107, 111, and 112 under 35 U.S.C. § 102(a) as being anticipated by Momirov.
2. The Examiner rejects claims 4, 6, 14, 16, 24, 26, 41, 51, 61, 65, 67, 73, 75, 81, 83, 94, 101, and 108-110 under 35 U.S.C. § 103(a) as being unpatentable over Momirov and Chauvel.
3. The Examiner rejects claims 31, 62, and 87 under 35 U.S.C. § 103(a) as being unpatentable over Momirov and Bigham.

ISSUE #1

Appellant asserts that “[c]onstructing a data packet,’ is distinguishable from forwarding a data packet as performed by the Momirov system” (App. Br. 9) because while “the Momirov system places a new header in front or behind the packet . . . [t]he original packet structure is untouched” (*id.* 9-10).

Did Appellant demonstrate that the Examiner erred in finding that Momirov discloses constructing a data packet?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. The term “constructing” includes “mak[ing] or form[ing] by combining or arranging parts or elements” or “set[ting] in logical order” (*Merriam-Webster’s Collegiate Dictionary* (11th ed., 2005)).
2. Momirov discloses “forwarding control information necessary for steering the data . . . may be prepended and/or appended to packets and/or associated fixed-length cells” (col. 8, ll. 31-35).
3. Momirov discloses that “the forwarding control information may include a multicast group identifier which is used by the switch core **215**, the optional switch access controller **225**, and the I/O interfaces **230** to forward the data to the appropriate output ports” (col. 8, ll. 38-42).
4. The term “terminal” includes any “part that forms the end” (*Merriam-Webster’s Collegiate Dictionary* (11th ed., 2005)).
5. Momirov discloses that “[w]hen the cell is part of a multicast packet, the destination address may represent a multicast group identifier. When the cell is part of a unicast packet, the destination address may be represented by a combination of a PID number and the PID port number” (col. 10, ll. 54-59).
6. Momirov discloses “the destination address may represent a 7-bit physical destination (e.g., a 5-bit PID number and a 4-bit port number) or a 7-bit multicast group identifier” (col. 10, ll. 59-62).
7. Momirov discloses “forwarding and filtering of multicast traffic” (col. 4, ll. 54-55) in which “[u]nicast data is linked to one of the

output queues associated with taps **0** through **N-1** and multicast data is linked to tap **M**” (col. 4, l. 66 – col. 5, l. 1).

8. Momirov discloses a “switching logic **310** . . . to determine upon which tap(s) a particular multicast cell is to be forwarded” by establishing “a correlation between multicast group information . . . and taps **216** that are associated with the multicast group information” (col. 5, ll. 6-12).
9. Momirov discloses “data that identifies those of the taps **216**, if any, that lead to one or more ports **240** that are members of a particular multicast group” (col. 5, ll. 13-15).
10. Momirov discloses a “5-bit tap vector . . . [that] represents a bit per tap bit vector (i.e., a vector with a status bit corresponding to each switch tap of the network device) that identifies those of the switch taps **216** whose associated I/O cards include one or more ports that are members of the multicast group” (col. 5, ll. 17-22).
11. The term “generate” includes “to define or originate . . . by the application of one or more rules or operations” (*Merriam-Webster’s Collegiate Dictionary* (11th ed., 2005)).
12. Chauvel also discloses transmitting data packets in a system “based on PID recognition” (col. 4, ll. 48-49) in which a “PID in the header corresponds to a PID stored in . . . memory” (col. 4, ll. 51-52) and when a “‘match’ signal” is detected (col. 4, ll. 52-53) between the PID in the header and the PID stored in memory, the PID “is used to

initiate the transport stream packet analysis and it enables the process to load the [other] bits coming from the transport stream headers” (col. 4, ll. 55-57).

PRINCIPLES OF LAW

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

“Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) “In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.” (*Id.*) (internal citations omitted).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and

(3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS (ISSUE #1)

We consider the Examiner’s rejection of claims 1-31, 111, and 112 as being anticipated by Momirov. Based on Appellant’s arguments in the Appeal Brief, we will decide the appeal with respect to issue #1 of the § 102(a) rejection over Momirov on the basis of claim 1 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Momirov discloses forming a data packet with “necessary” control information by attaching the necessary information to the packet (FF 2). Because constructing a data packet, construed broadly but reasonably, includes making or forming by combining parts or elements (FF 1), we agree with the Examiner that Momirov discloses “constructing” (i.e., forming by combining parts or elements) a data packet by “combining” necessary information with pre-existing data in a data packet.

Appellant argues that the “original packet structure is untouched” (App. Br. 10). Even assuming Appellant’s argument to be correct, we are unpersuaded by Appellant because, under a broad but reasonable construction of the term “constructing,” “constructing” an entity merely

includes forming the entity by combining parts or elements of the entity and does not require alteration of each part or element of the entity as a whole.

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 1, and of claims 2-31, 111, and 112 which fall therewith, with respect to issue #1.

ISSUE #2

Appellant asserts that "Momirov is further deficient in that it deals with routing only within one device" (App. Br. 10) as opposed to "the new 'address value' [being] evaluated in a different device (e.g., a receiving terminal as recited in claim 1), which is separate from the device which generates the address value" (*id.*).

Did Appellant demonstrate that the Examiner erred in finding that Momirov discloses that a field of a header will be used by a receiving terminal?

ANALYSIS (ISSUE #2)

Since Appellant's arguments have treated claims 1-31, 111, and 112 as a single group which stand or fall together with respect to issue #2, we select independent claim 1 as the representative claim for this group with respect to issue #2. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Momirov discloses information in a data packet that is used by different components (e.g., switch core, controller, or interfaces) to forward the data in the data packet to “appropriate output ports” (FF 3). Because a “terminal” includes any “part that forms the end” (FF 4) and the “appropriate output ports” of Momirov includes “parts” of the system that form a receiving end (i.e., receive the data), we agree with the Examiner that Momirov discloses a “receiving terminal” (i.e., a part that forms an end and that receives information, for example).

Appellant argues that Momirov does not disclose “a different device . . . which is separate from the device which generates the address value” (App. Br. 10). First, claim 1 does not recite “a different device” or a device “separate from” any other device. Second, even assuming claim 1 recites “a different device,” Momirov discloses a switch core, a switch access controller, I/O interfaces, and output ports (i.e., “terminal devices”), each device being “different” from each of the other devices. Therefore, we are unpersuaded by Appellant’s argument.

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of claim 1, and of claims 2-31, 111, and 112 which fall therewith with respect to issue #2.

ISSUE #3

Appellant asserts that “[t]here is no recitation or implication in Momirov that the IP or MAC address . . . has been operated upon by a bitwise logic function or a hashing function” (App. Br. 10).

Did Appellant demonstrate that the Examiner erred in finding that Momirov discloses an address that has been operated upon by bitwise logic function or a hashing function?

ANALYSIS (ISSUE #3)

As above, Momirov discloses constructing data packets with control information (FF 3), the control information including an address that includes destination information that may include “a 7-bit” address or group identifier (FF 5-6). Hence, Momirov discloses generating destination information that includes, for example, a “7-bit” address or group identifier. The Specification fails to provide a definition for “bitwise logic function” or “hashing function.” In the absence of a definition, we adopt a plain and customary meaning of the term “bitwise logic function” to include any operation (i.e., “function”) that manipulates or otherwise processes bits (i.e., “bitwise”) of information. We also adopt a plain and customary meaning of the term “hashing function” to include any operation that converts a large amount of data into a smaller amount of data that serves as an index or identifier. Because Momirov discloses generating an address comprising “bits,” we agree with the Examiner that the addresses of Momirov,

comprising bits, is generated using an operation that manipulates bits (i.e., a “bitwise logic function”). Likewise, the address of Momirov is generated from a large amount of information and serves as an identifier (i.e., is operated on by a “hashing function” that converts a large amount of data into a smaller amount of data that serves as an identifier).

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of claims 8 and 9 with respect to issue #3.

ISSUE #4

Appellant asserts that “[t]he Examiner . . . has not provided an adequate grounds of rejection to claims that . . . include limitations distinct from both the previously presented claims and the previously cited references” (App. Br. 11-12).

The Examiner finds that “claims 111-112 were examined and determined to be of the same scope as claims 1-3, 5, and 7-10” (Ans. 15) because claims 111 and 112 “contain negative limitations . . . that are disclosed in the original specification” (*id.*) and because “applicant has also disclosed these limitations in the background information as prior art information” (*id.*).

Did Appellant demonstrate that the Examiner erred in determining that Momirov discloses the features recited in claims 111 and 112?

ANALYSIS (ISSUE #4)

As above, Momirov discloses address information in data packets that identify a location to forward the data packet at an “appropriate output port” (FF 2-3) and an address that is formatted to “represent a 7-bit physical destination . . . or a 7-bit multicast group identifier” (FF 6). In addition, we do not find, and Appellant has not demonstrated, that Momirov discloses that the location to forward the packet is determined by any other component other than the address. Therefore, we agree with the Examiner that Momirov discloses that the selection (i.e., determination of the destination to transmit a data packet) is based only on a formatted address value (i.e., the destination address formatted to represent a physical destination or group identifier), as recited in claim 111.²

Claim 112 recites a selection criteria that is established “without the use of tables used to link the PID to the multicast IP address” (Claims Appx. 37). While the Examiner finds that claim 112 was “examined and determined to be of the same scope as claims 1-3, 5, and 7-10” (Ans. 15) and that features recited in claim 112 “are disclosed in the original specification or claims” (*id.*), the Examiner has not demonstrated, much less asserted, that the features recited in claim 112 are disclosed in Momirov.

² We note a typographical error in claim 111. Specifically, claim 111 recites that “the selection criteria is based only formatted address value” which appears erroneous. We assume that claim 111 was intended to recite that the selection criteria is based only on a formatted address value.

For at least the aforementioned reasons, we conclude that Appellant has met their burden of showing that the Examiner erred in rejecting claim 112 but has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 111 with respect to issue #4.

ISSUE #5

The Examiner finds that “[c]laim 63 is rejected in the same scope as of claim 1 rejection” (Ans. 16).

Appellant asserts that claims 63, 71, and 79 recite “(2) generating a status value to identify the packet as part of a multicast data stream” (App. Br. 13) and “have not been appropriately considered by the Examiner” (*id.*). Similarly, Appellant argues that claims 88, 95, and 102 recite “(2) generating a status value to identify the packet as part of a multicast data stream” (App. Br. 15) and “have not been appropriately considered by the Examiner” (*id.*).

Did Appellant demonstrate that the Examiner erred in finding that Momirov discloses generating a status value to identify the packet as part of a multicast data stream?

ANALYSIS (ISSUE #5)

Since Appellant's arguments have treated claims 63-108 as a single group which stand or fall together with respect to issue #5,³ we select independent claim 63 as the representative claim for this group with respect to issue #5. *See* 37 C.F.R. § 41.37(c)(1)(vii).

As above, Momirov discloses information in a data packet indicating forwarding information for the data packet (FF 1-2) such that unicast data and multicast data are differentiated (FF 7-8) and linked to a corresponding tap (FF 7-8). In addition, Momirov discloses that the information includes a vector with a “status bit” that identifies members of a multicast group to receive multicast data (FF 9-10). We agree with the Examiner that Momirov discloses a status bit as recited in claim 63 because the status bit disclosed by Momirov is included in address information of a data packet (i.e., a status bit in a vector) and identifies data as multicast data (i.e., indicates ports that are members of a multicast group as opposed to unicast data for unicast members).

Appellant argues that claim 63 has “not been appropriately considered by the Examiner” (App. Br. 13). We disagree with Appellant’s contention since, as described above, Momirov discloses the disputed claim feature.

³ Appellant argues claims 88, 95, and 102 (and corresponding dependent claims) under a separate heading but provide the same arguments as those provided for claims 63, 71, and 79 (and corresponding dependent claims).

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claims 63, and of claims 64-108 which fall therewith, with respect to issue #5.

ISSUE #6

Appellant asserts that “‘generating’ . . . is at least a calculation or computation that amounts to data manipulation more substantial than looking up information in a cross-reference table” (App. Br. 14) and concludes that “[t]his process is distinct from Momirov, wherein cross-reference tables are used (e.g., FIG. 5, 6 and column 8, line 66- column 9 line 31)” (*id.*).

Did Appellant demonstrate that the Examiner erred in finding that Momirov discloses generating a value for a field in a header?

ANALYSIS (ISSUE #6)

Since Appellant's arguments have treated claims 32-62 as a single group which stand or fall together with respect to issue #6, we select independent claim 32 as the representative claim for this group with respect to issue #6. *See* 37 C.F.R. § 41.37(c)(1)(vii).

In the absence of a definition of the term “generate” in the Specification, we adopt a broad but reasonable meaning of the term to include defining or originating an entity by the application of a rule or

operation (FF 11). As above, Momirov discloses forming a data packet with “necessary” control information by attaching the necessary information to the packet (FF 2). In forming the data packet with control information, we agree that Momirov also “originates” the data packet/control information by applying at least one operation (or rule). Because Momirov’s disclosure comports with “generating” the desired data packet with control information, we agree that Momirov discloses generating a value as recited.

Appellant argues that Momirov discloses “looking up information in a cross-reference table” (App. Br. 14). Even assuming Appellant’s contention to be correct that Momirov discloses looking up information in a table, this alleged fact does not support Appellant’s contention that Momirov also fails to disclose generating a value. To the contrary, as set forth above, Momirov appears to disclose generating a value.

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of claims 32-62 with respect to issue #6.

ISSUE #7

Appellant asserts that the Examiner’s stated motivation to combine the cited references “seems to . . . mirror the benefits recited by the present invention . . . [and] is deemed to constitute impermissible hindsight reconstruction by the Examiner (e.g., the Examiner combined the references

only because of the teaching of the present invention), and therefore, Appellants believe the rejections to be invalid" (App. Br. 17).

Did Appellant demonstrate that the Examiner erred in finding that it would have been obvious to one of ordinary skill in the art to have combined the teachings of Momirov and Chauvel?

ANALYSIS (ISSUE #7)

As above, Momirov discloses transmitting data packets in a system including constructing or generating data packets with control information that is used to determine a forwarding destination address (which may include a PID number and/or PID port number) corresponding to a multicast group (FF 1-3, 5). Chauvel also discloses transmitting data packets and processing data in the data packet "based on PID recognition" (FF 12), by matching a stored PID with a "PID in the header corresponds to a PID stored in . . . memory" (FF 12). Hence, both Momirov and Chauvel disclose known methods of transmitting and processing data packet information involving determining PID information from within a header of the data packet.

The combination of such familiar elements of Momirov and Chauvel (i.e., processing data packet information based on PID information obtained from the data packet header) would have entailed only arranging known elements performing known functions to result in no more than the expected result of the transmission and processing of data packet information.

Because “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results” *KSR*, 550 U.S. at 416, we agree that it would have been obvious to one of ordinary skill in the art to have combined Momirov and Chauvel.

In any event, Appellant has provided no evidence to show that effecting such a combination was “uniquely challenging or difficult for one of ordinary skill in the art.” *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 419).

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of claims 4, 6, 14, 16, 24, 26, 41, 51, 61, 65, 67, 73, 75, 81, 83, 94, 101, and 108-110 with respect to issue #7.

ISSUE #8

Appellant asserts that “Chauvel does not cure any of the deficiencies . . . in respect to the Momirov reference alone” (App. Br. 17).

Did Appellant demonstrate that the Examiner erred in finding that the combination of Chauvel and Momirov discloses or suggests the claimed invention?

ANALYSIS (ISSUE #8)

Appellant has not demonstrated any “deficiencies . . . in respect to the Momirov reference alone” with respect to the claimed invention. Therefore, we are unpersuaded by Appellant’s argument.

For at least the aforementioned reason, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of claims 4, 6, 14, 16, 24, 26, 41, 51, 61, 65, 67, 73, 75, 81, 83, 94, 101, and 108-110 with respect to issue #8.

ISSUE #9

Appellant asserts that “the wireless communication device in Bigham is merely a receiving device, and is not employed to process and route data as required by claims 31, 62 and 87 of the present invention” (App. Br. 18).

Did Appellant demonstrate that the Examiner erred in finding that claims 31, 62, and 87 are unpatentable over the combination of Momirov and Bigham?

ANALYSIS (ISSUE #9)

Since Appellant’s arguments have treated claims 31, 62, and 87 as a single group which stand or fall together with respect to issue #9, we select claim 31 as the representative claim for this group with respect to issue #9. *See* 37 C.F.R. § 41.37(c)(1)(vii).

As above, Momirov discloses constructing or generating data packets with control information that is used to determine a forwarding destination address for the data packets corresponding to a multicast group (FF 1-3, 5). The Examiner further finds that Bigham discloses transmitting data streams “wherein the apparatus is a wireless handheld terminal (abstract; column 32, line 8-21)” (Ans. 11). Based on the record before us, we find that the combination of Momirov and Bigham discloses or suggests each element recited in claim 31.

Appellant argues that Bigham does not disclose that an apparatus is “employed to process and route data as required by claims 31, 62 and 87” (App. Br. 18). However, the Examiner relies on Momirov to provide this disclosure. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413 (CCPA 1981).

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of claim 31, and of claims 62 and 87 which fall therewith with respect to issue #9.

II. New Ground of Rejection -- 37 C.F.R. § 41.50(b)

We reject claim 112 under 35 U.S.C. § 112, second paragraph as being indefinite.

Claim 112 recites “used to link the PID to the multicast IP address” (Claims Appx. 37). The claim contains no earlier recitation or limitation of a PID or a multicast IP address and is thus indefinite because it is unclear as to what element the limitations are making reference.

Claim 112 thus fails to pass muster under 35 U.S.C. § 112, second paragraph.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has failed to demonstrate that the Examiner erred in:

1. finding that Momirov discloses a method for constructing a data packet (issue #1),
2. finding that Momirov discloses that a field of a header will be used by a receiving terminal (issue #2),
3. finding that Momirov discloses an address that has been operated upon by bitwise logic function or a hashing function (issue #3),
4. determining that Momirov discloses the features recited in claim 111 (issue #4),
5. finding that Momirov discloses generating a status value to identify the packet as part of a multicast data stream (issue #5),
6. finding that Momirov discloses generating a value for a field in a header (issue #6),

7. finding that it would have been obvious to one of ordinary skill in the art to have combined the teachings of Momirov and Chauvel (issue #7),

8. finding that the combination of Chauvel and Momirov discloses or suggests the claimed invention (issue #8), and

9. finding that claims 31, 62, and 87 are unpatentable over the combination of Momirov and Bigham (issue #9).

However, Appellant has demonstrated that the Examiner erred in determining that Momirov discloses the features recited in claim 112 (issue #4).

DECISION

We affirm the Examiner's decision rejecting claims 1-3, 5, 7-13, 15, 17-23, 25, 27-30, 32-40, 42-50, 52-60, 63, 64, 66, 68-72, 74, 76-80, 82, 84-86, 88-93, 95-100, 102-107, and 111 under 35 U.S.C. § 102(a) and claims 4, 6, 14, 16, 24, 26, 31, 41, 51, 61, 62, 65, 67, 73, 75, 81, 83, 87, 94, 101, and 108-110 under 35 U.S.C. § 103(a). We reverse the Examiner's decision rejecting claim 112 under 35 U.S.C. § 102(a).

In a new ground of rejection, we have rejected claim 112 under 35 U.S.C. § 112, second paragraph as being indefinite.

In addition to reversing the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of

rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elects to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

Appeal 2008-002152
Application 09/990,039

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

rwk

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